



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/677,746	10/03/2000	Michael E. Reedy	3142/34	4391

27383 7590 02/26/2002

CLIFFORD CHANCE ROGERS & WELLS LLP
200 PARK AVENUE
NEW YORK, NY 10166

EXAMINER

KUHNS, ALLAN R

ART UNIT	PAPER NUMBER
----------	--------------

1732

DATE MAILED: 02/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

T-D-8

Office Action Summary

Application No.
09/677,746

Applicant(s)
REEDY, ET AL

Examiner
KUHNS

Group Art Unit
1732

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

THREE(3)

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

NOV. 26, 2001

- ☒ Responsive to communication(s) filed on
- ☒ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-50 is/are pending in the application.
- Of the above claim(s) is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☒ Claim(s) 1-50 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number)
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received:

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s).
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☒ Other RESPONSE TO RESTRICTION (08/163,410) AMENDMENT (08/702,922)

Office Action Summary

Art Unit: 1732

1. The reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based, as set forth in the previous Office action. See 37 CFR 1.175(a)(1) and MPEP § 1414.
2. Claims 1-50 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.
3. Applicants have submitted a preliminary amendment, and a review of the file does not show compliance with rule 37 CFR 1.173(c). Each amendatory change, when first submitted, must be accompanied by an explanation of the support in the disclosure of the patent for the change (along with any additional comments) on page(s) separate from the page(s) containing the amendment. 37CFR 1.173(c). Applicants have failed to comply with this requirement concerning claims 19-50 in the amendment in which these claims were initially filed.
4. Applicants' arguments filed November 26, 2001 have been fully considered but they are not persuasive. Applicants assert that the open ended phraseology used with respect to the additive may have been overbroad and rendered claims 19-50 invalid, also in view of applicants' prior U.S. Patent Nos. 5,218,006, 5,302,624, 5,342,857, and 5,403,865. But it is the examiner's position that if claims 19-50 were invalid over any of the prior patents of applicants, the filing of claims 19-50 in this reissue application would have the effect of introducing error into the reissue application, rather than correcting an error in Pat. No. 5,817,261.

Applicants argue that none of the prior patents having issued from this application contain claims directed to additives, per se, such that the (instantly) claimed additives could not have been

Art Unit: 1732

subject to a restriction requirement and thus could not be said to now be claimed due to the failure to timely file a divisional application. But the additive was claimed previously, for example in the composition of claim 2 of Serial No. 07/995,289, and this claim was subject to a restriction requirement. Applicants are now claiming the additive in broader form than it was previously claimed.

Applicants further argue that in each of the prior applications to which a restriction was directed, i.e. Ser. Nos. 07/995,289, 08/163,010 and 08/702,922, those restriction requirements were all traversed by applicants, and applicants are not relying on the failure to file a timely divisional application as the error upon which this reissue application is based. But it is the examiner's position that failure to timely file a divisional application is effectively the error leading to the filing of claims 19-50 because applicants had the opportunity to file a timely divisional application and did not avail themselves of this opportunity.

Applicants additionally argue that the facts of this reissue application are believed to take it outside of In re Orita because, in that case, the restriction required between the two sets of claims was not traversed, and applicants realized that they had forsaken the opportunity to file a timely divisional application. This is not persuasive because Orita focuses its holding on acquiescence of applicants, and in the case now at issue, applicants have acquiesced to a restriction requirement on three occasions. Applicants' Tab A filed November 26, 2001 illustrates acquiescence in 07/995,289 in a first Office action when the examiner in that application was instructed to delete claims 2, 3 and 5. Applicants also acquiesced to the restriction requirement in

Art Unit: 1732

08/163,010 by canceling claims 2, 3 and 5 in an amendment filed October 18, 1994 (see attachment). Applicants also acquiesced to the restriction requirement in 08/702,922 by canceling claims 7 and 9 in an amendment filed July 3, 1997 (see attachment).

Applicants also argue that the claims added in this reissue application, i.e. claims 19-50, were not subject to a restriction requirement in any of the prior applications, and the claims added in this reissue application are tied directly to the process claims which were patented in the patent for which reissue is sought and the claims added in this reissue application are part and parcel of the same invention as the patented process claims. But it is the examiner's position that claims 19-50 would definitely have been subject to restriction if presented in 08/702,922, and that claims 19-50 are independent and distinct from process claims 1-18 of Pat. No. 5,817,261.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire **THREE MONTHS** from the date of this action. In the event a first response is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 1732

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allan Kuhns whose telephone number is (703) 308-3462. The examiner can normally be reached on Monday to Thursday from 7:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan Silbaugh, can be reached on (703) 308-3829. The fax phone number for this Group is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Allan R. Kuhns
ALLAN R. KUHNS
PRIMARY EXAMINER AU 1732
2-8-02